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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,813	05/09/2001	Tadamasa Kitsukawa	080398.P159D	5615

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EXAMINER

LAMBRECHT, CHRISTOPHER M

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/852,813

Applicant(s)

KITSUKAWA ET AL.

Examiner

Christopher M. Lambrecht

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/9/2001</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. **Claims 1-55** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,282,713. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application represent well-known and/or obvious modifications over the patented claims.

For example, regarding **claim 1** of the instant application, patented claim 1 recites all of the limitations of claim 1 of the instant application except "receiving data that links the advertising information to the corresponding scene". Receiving said data in interactive television systems is well known in the art for the benefit of providing the system with a means for referencing advertising data and/or additional information with regard to a particular scene of an interactive program.

Accordingly, it would have been obvious to one of ordinary skill in the art to at the time the invention was made to modify patented claim 1 to include receiving data that links advertising information to the corresponding scene, for the benefit of enabling a viewer to retrieve advertising information received along with an interactive program related to a scene of interest to the viewer.

Independent **claims 12, 19, 26, 32, 40, 46, and 51** recite similar subject matter and as such are also obvious in view of the patented claims.

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Allowance of claims 1, 12, 19, 26, 32, 40, 46, and 51 would result in the unwanted time-wise extension of the monopoly granted for the invention as defined in patented claims 1-54.

Additional limitations recited in dependent claims throughout the instant application further conflict with subject matter recited by the patented claims. For example,

Claims 2, 20, 27, 37 and 53 of the instant application conflict with patented claim 12.

Claims 3, 21, 38, 44, and 54 of the instant application conflict with patented claim 13.

Claims 4, 13, 22, and 29 of the instant application conflict with patented claim 17.

Claims 5, 14, and 23 of the instant application conflict with patented claim 2.

Claims 6, 15, 33, 41, 47, and 52 of the instant application conflict with patented claim 3.

Claim 7 of the instant application conflicts with patented claim 4.

Claims 8, 16, 24, and 30 of the instant application conflict with patented claim 7.

Claims 9, 17, 25, 31, 35, 43, and 49 of the instant application conflict with patented claim 8.

Claim 10 of the instant application conflicts with patented claim 19.

Claims 11 and 18 of the instant application conflict with patented claim 20.

Claims 34, 42, and 48 of the instant application conflict with patented claim 5.

Claims 36 of the instant application conflict with patented claim 10.

Claims 39, 45, 50, and 55 of the instant application conflict with patented claim 14.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-4, 6-10, 12, 13, 15-17, 19-22, and 24-55** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,496,981 to Wistendahl et al. (hereinafter “Wistendahl”).

Regarding **claims 1, 12, 19, and 26**, Wistendahl discloses a receiver, apparatus, and corresponding machine-readable medium of instructions for performing a method, comprising:

a storage device having stored therein an advertising routine (IDM program, col. 5, ll. 39-50) for the reception, timing, and display of advertising marks and associated program broadcasts and

a processor coupled to the storage device for executing the advertising routine (col. 8, ll. 36-48) by:

receiving advertising information for an item along with a broadcast of a program, wherein the item is associated with a scene of the program (col. 13, ll. 50-62);

receiving data that links the advertising information to the corresponding scene (col. 6, ll. 16-32 & 45-55);

displaying an advertising mark for the item on a display along with the corresponding scene to alert a viewer when advertising information is available for the item (col. 15, ll. 1-7); and

upon selection of the advertising mark by a viewer, displaying the advertising information on the display along with the broadcast of a program (col. 9, ll. 33-41).

As to **claims 2, 20, and 27**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium for performing the method of claims 1, 12, 19, and 26, wherein the advertising information is received simultaneously with the scene in which the item appears (col. 3, ll. 45-60).

As to **claims 3, 21, and 28**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium for performing the method of claim 1, 12, 19, and 26, wherein the advertising

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information is received prior to receipt of the broadcasted program, and wherein the prior received advertising information is stored in association with the links to the corresponding scene (col. 7, l. 53 - col. 8, l. 8).

As to **claims 4, 13, 22, and 29**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium for performing the method of claims 1, 12, 19, and 26, further comprising controlling the presentation of the advertising information using an electronic program guide, where the electronic program guide provides programming information that can be associated with the links to the corresponding scene (col. 8, ll. 21-36).

As to **claims 6, and 15**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium for performing the method of claims 1, 12, 19, and 26, further comprising providing an alert to a viewer when advertising information is available for an item in a displayed scene, wherein the alert comprises a displayed advertising mark (col. 15, ll. 1-7).

As to **claim 7**, Wistendahl discloses the method of claim 1, wherein the displayed scene comprises currently displayed scenes, previously displayed scenes, and scenes that are to be displayed in the future (col.10, ll. 46-53).

As to **claims 8, 16, 24, and 30**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium for performing the method of claims 1, 12, 19, and 26, wherein the advertising information is for a plurality of items (col. 13, ll. 50-62), wherein the displayed advertising mark comprises an indicator for each item for which advertising information is available (col. 15, ll. 53-56), and wherein the indicator is representative of the item to which the indicator corresponds (i.e., halos overlaying the interactive hot spots).

As to **claims 9, 17, 25, and 31**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium for performing the method of claims 8, 12, 19, and 26, further comprising

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receiving a viewer selection of an indicator corresponding to an item and displaying the advertising information associated with the corresponding item (col. 13, ll. 50-63).

As to **claim 10**, Wistendahl discloses the method of claim 1, further comprising receiving a request from the viewer for electronically ordering the item using the advertising information (col. 9, ll. 28-41).

Regarding **claim 32, 40, 46, and 51**, Wistendahl discloses a receiver, apparatus, and corresponding machine-readable medium of instructions for performing a method, comprising:

a storage device having stored therein an advertising routine (IDM program, col. 5, ll. 39-50) for reception, synchronization and display of advertising information and associated program broadcasts and

a processor (col. 8, ll. 36-48) coupled to the storage device for executing the advertising routine by:

receiving advertising information for at least one item along with a broadcast of a program (col. 13, ll. 50-62);

synchronizing the advertising information with the display of a corresponding at least one item during the broadcast of the program (col. 10, ll. 36-56)

providing an alert to the viewer when advertising information is available for the item (col. 15, ll. 1-7); and

displaying the advertising information on the display along with the broadcast of a program upon the receipt of a selection from the viewer (col. 9, ll. 33-41).

As to **claims 33, 41, 47, and 52**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium of instructions for performing the method of claims 32, 40, 46, and 51, further comprising providing an alert to a viewer when advertising information is available for an item in a displayed scene, wherein the alert comprises a displayed advertising mark (col. 15, ll. 1-7).

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As to **claims 34, 42, and 48**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium of instructions for performing the method of claims 32, 40, and 46, wherein the at least one display mark is superimposed over the broadcast of a program on the display, and wherein the at least one display mark comprises an indicator for each advertisement (col. 15, ll. 53-56).

As to **claims 35, 43, and 49**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium of instructions for performing the method of claims 32, 40, and 46, further comprising enabling a request for the advertising information, wherein enabling a request comprises selecting an advertisement indicator corresponding to an item in which the viewer is interested (col. 9, ll. 33-41), and wherein selecting the advertisement indicator results in the display of detailed advertisement information (col.13, ll. 50-62).

As to **claim 36**, Wistendahl discloses the method of claim 32, wherein displaying comprises superimposing the advertising information over the broadcast program on the display (col. 13, ll. 50-54).

As to **claims 37 and 53**, Wistendahl discloses the receiver and corresponding method of claims 32 and 51, wherein the advertising information is received simultaneously with the broadcast of a program (col. 3, ll. 45-60).

As to **claims 38, 44, and 54**, Wistendahl discloses the receiver and corresponding machine-readable medium of instructions for performing the method of claims 32, 40, and 51, wherein the advertising information is received prior to the broadcast of a program (col. 7, l. 53 - col. 8, l. 8).

As to **claims 39, 45, 50, and 55**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium of instructions for performing the method of claims 32, 40, 46, and 51, further comprising receiving timing data that links the advertising information to the corresponding broadcast of a program and wherein synchronizing the advertising information comprises using timing data (col. 10, ll. 46-56).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 5, 11, 18, and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wistendahl in view of U.S. Patent No. 5,285,278 to Holman (hereinafter "Holman").

Regarding **claims 5, 14, and 23**, Wistendahl discloses the receiver, apparatus, and corresponding machine-readable medium for performing the method claims 1, 12, 19, and 26, but fails to disclose storing received advertising information on a smart card; and storing information on the smart card regarding the associated broadcasted program in associated with the advertising information.

In an analogous art, Holman discloses storing received advertising information (coupon) on a smart card (microelectronic circuit card, col. 4, ll. 49-54 and col. 5, ll. 51-55); and storing information on the smart card regarding the associated broadcasted program in associated with the advertising information (col. 9, ll. 59-64), for the benefit of providing useful information to the product manufacturer (col. 9, ll. 59-64).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Wistendahl to include storing received advertising information on a smart card; and storing information on the smart card regarding the associated broadcasted program in associated with the advertising information, as taught by Holman, for the benefit of providing useful information to the product manufacturer.

Regarding **claims 11 and 18**, Wistendahl discloses the receiver, apparatus, and corresponding machine readable medium for performing the method claims 1, 12, 19, and 26, further comprising storing

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advertising information for the item, but fails to disclose storing said information for a pre-specified period of time after the corresponding broadcasted program ends.

In an analogous art, Holman discloses storing advertising information (coupon) for an item for a pre-specified period of time after a corresponding broadcast program ends (col. 12, ll. 21-29), for the benefit of preventing abuse of a promotional offer (col. 12, ll. 21-37).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Wistendahl to include storing advertising information for an item for a pre-specified period of time after a corresponding broadcast program ends, as taught by Holman, for the benefit of preventing abuse of a promotional offer.

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Conclusion

7. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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on _____.
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Registration Number: _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) ____ - ____ on _____.
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Registration Number: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Lambrecht whose telephone number is (571) 272-7297. The examiner can normally be reached on 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher M Lambrecht
Examiner
Art Unit 2611

CML



HAI TRAN
PRIMARY EXAMINER